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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,398	04/12/2004	Thomas H. Quinn	14369.8USU1	3234

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EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/823,398

Applicant(s)

QUINN, THOMAS H.

Examiner

Judy M. Reddick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04/12/04; 06/30/04; 07/12/04.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 06/30/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 06/30/04 has been considered and scanned into the application file.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) The recited contents governing components (a), (b) & (c) per claims 1 & 7, the "polymer" per claims 2 & 8, the "hydrogenated block copolymer" per claims 4 & 10, and the "resin", "oil" and "wax" per claims 5, 6, 11 & 12 constitutes indefinite subject matter as per the entity that said contents are being based on is not readily ascertainable, i.e., total adhesive or else.

B) The recited "the material" per claims 1 & 7 constitutes indefinite subject matter as per the non-express establishment of proper antecedent basis. Furthermore, it is not clear as to what "the material" is referencing, "(a)", "(b)" and/or "(c)" or else.

C) The recited "wherein the adhesive additionally comprises 40 to 90 wt-% resin, 0.1 to 18 wt-% oil and 0.1 to 18 wt-% wax" per claim 5 and "wherein the adhesive additionally comprises 50 to 85 wt-% resin, 0.2 to 15 wt-% oil and 0.2 to 15 wt-% wax" per claim 6 constitutes indefinite subject matter as per it not being readily ascertainable, in light of the term "additionally", if such is further limiting the antecedently recited components (a), (b) and (c) or an additional "resin", "oil" and "wax" is intended. It is suggested that the term "additionally" be cancelled so as to avoid any confusion. See also claims 11 & 12 in this regard.

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D) The recited "40 to 90 wt-% resin, 0.1 to 18 wt-% oil and 0.1 to 18 wt-% wax" per claim 11 and "50 to 85 wt-% resin, 0.2 to 15 wt-% oil and 0.2 to 15 wt-% wax" per claim 12 constitutes indefinite subject matter as per it not being readily ascertainable as to how such further limits the antecedently recited (a) at least 70 to 85 wt-% resin, (b) about 5 to 12 wt-% hydrocarbon oil and (c) about 6 to 15 wt-% of a wax" per claim 7.

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: As far as the Examiner can tell, no express antecedent basis can be found for the following claim limitations; i) "at least 30 wt-% of a hydrogenated synthetic resin", "about 0.1 to 20 wt-% of a hydrocarbon oil" and "about 0.1 to 25 wt-% of a wax" per claim 1; "about 0.1 to about 7 wt-% of a polymer" per claims 2 & 7; "at least 70 to 85 wt-% of a hydrogenated synthetic resin", "about 5 to 12 wt-% of a hydrocarbon oil" and "about 6 to 15 wt-% of a wax" per claim 7.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3, 5-7, 9, 11 & 12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Horsey et al (U.S. 5,128,397).

8. Horsey et al teach hot melt adhesive compositions defined basically as containing a) an ethylene-vinyl acetate copolymer, b) 10 to 90 wt. % and preferably 25 to 50 wt. % of a tackifying resin which includes hydrogenated aliphatic petroleum hydrocarbon resins, hydrogenated polyterpene hydrocarbon resins, etc., c) 0 to 50 wt. % of waxes which include petroleum derived waxes, paraffin and microcrystalline waxes, d) up to 50 wt. % of plasticizing or extending oils such as naphthenic oils and e) additional additives which include a hindered phenol antioxidant (the Abstract, col. 1, lines 52-68, col. 2, lines 1-40, col. 8, lines 6-6-31, the Runs and Claims). Horsey et al therefore anticipate the instantly claimed invention with the understanding that the adhesive composition of Horsey et al overlaps in scope with the claimed composition.

While it appears that the claimed properties such as Gardner Color and viscosity are met by the adhesive composition of Horsey et al (col. 9, lines 4-13), it would be expected that the adhesive compositions of Horsey et al, if measured under the same conditions as the claimed adhesive, would meet the claimed properties such as color, softening point viscosity and pick-up since the adhesive composition of Horsey et al is essentially the same as and made under essentially the same conditions as the claimed adhesive composition.

It has been held that where applicants claims a composition in terms of function, property of characteristic where said function is not explicitly shown by the reference and where the Examiner has explained why the function, property or characteristics is considered inherent in the prior art, it is appropriate for the Examiner to make a rejection under both the applicable sections of 35 USC 102 and 35 USC 103 such that the burden is placed upon applicant to provide clear evidence that the respective compositions do, in fact, differ as provided for under the guise of *In re Best*, 195 USPQ 430, 433 (CCPA 1977); *In re Fitzgerald et al*, 205 USPQ 594.

As to the dependent claims it appears that all of the limitations are met per Horsey et al. However, if not taught or suggested, the claim limitations would have been obvious to the skilled artisan and with a reasonable expectation of success, i.e., any additional or particular claim parameters which may not be specifically set out in the references are

considered to be inherent in the reference products or not to involve anything unobvious absent a showing to the contrary.

Even if it turns out that the Examiner has somehow missed the boat and the claims are not anticipated by the disclosure of Horsey, it would have been obvious to the skilled artisan to extrapolate, from Horsey et al, the precisely defined composition, as claimed, as per such having been within the purview of the general disclosure of Horsey et al and with a reasonable expectation of success.

Claim Rejections - 35 USC § 102

9. Claims 1-6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kueppers (U.S. 5,939,483).

Kueppers teaches a hot melt defined basically as containing a) from 10 to about 40 wt. % of a block copolymer which includes hydrogenated block polymers such as Kraton D-1124 & Quintac 3450 (4), b) from 0 to about 20 wt. % of a compatible polymer (2) wherein the total polymer content does not exceed 40 wt. %, c) from about 25 to about 60 wt. % of at least one tackifying resin which includes hydrogenated synthetic hydrocarbon resins (1 (a), 5 & 6), d) from about 10 to about 40 wt. % of a compatible plasticizer such as hydrocarbon oils (1 (b), 5 & 6), e) from about 10 to about 40 wt. % of a wax component such as paraffin and microcrystalline waxes (1 (c), 5 and 6) and f) a stabilizer or antioxidant which includes Irganox 1010 which is a hindered phenol (3). See the Abstract, col. 4, lines 16-67, col. 5, lines 1-67, col. 6, lines 1-67, col. 7, lines 1-67, the Runs and claims. Kueppers therefore anticipates the instantly claimed invention with the understanding that the hot melt composition of Kueppers overlaps in scope with the claimed hot melt adhesive.

As to the properties "pick-up", "Color", "softening point" and "viscosity", it would be expected that these properties would be met by the hot melt of Kueppers, if measured under the same conditions as the claimed adhesive, since it is essentially the same as and made under essentially the same conditions as the claimed hot melt.

It has been held that where applicants claims a composition in terms of function, property of characteristic where said function is not explicitly shown by the reference and where the Examiner has explained why the function, property or

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characteristics is considered inherent in the prior art, it is appropriate for the Examiner to make a rejection under both the applicable sections of 35 USC 102 and 35 USC 103 such that the burden is placed upon applicant to provide clear evidence that the respective compositions do, in fact, differ as provided for under the guise of *In re Best*, 195 USPQ 430, 433(CCPA 1977); *In re Fitzgerald et al*, 205 USPQ 594.

Even if it turns out that the Examiner has somehow missed the boat and the claims are not anticipated by the disclosure of Kueppers, it would have been obvious to the skilled artisan to extrapolate, from Kueppers, the hot melt, as claimed, as per such having been within the purview of Kueppers general disclosure and with a reasonable expectation of success.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Keyzer et al (U.S. 6,657,000 B1).

De Keyzer et al teach hot melt adhesives defined basically as containing a) from 5 to less than 15 wt. % of a blend of (i) a hydrogenated block copolymer and (ii) a homogeneous linear or substantially linear

interpolymer of ethylene (2, 4, 8 and 10), b) from 50 to 80 wt. % of a tackifying resin which includes hydrogenated synthetic resins such as C5 hydrocarbon resins, C5/C9 hydrocarbon resins, C9 hydrocarbon resins, etc. (1 (a), 7 (a), 5, 6, 11 & 12), c) from 5 to 35 wt. % of plasticizing oil which includes hydrocarbon oils such as paraffinic and naphthenic hydrocarbon oils (1 (b), 7 (b), 5, 6, 11 & 12), and d) other conventional additives which include paraffin and microcrystalline waxes (1 (c), 7 (c), 5, 6, 11 & 12), antioxidants such as hindered phenols, etc. (3 & 9).

The disclosure of De Keyzer et al differs basically from the claimed invention with respect to the amount of wax component, i.e., the content of wax component per De Keyzer et al is generic to the claimed wax component content and necessarily implies that any content of wax, including the claimed content of wax, would have been operable within the scope of patentees invention and with a reasonable expectation of success, absent some evidence of unusual or unexpected results commensurate in scope with the claims.

As to the properties, as claimed, it is tenable that these properties may be met by De Keyzer et al, as modified, since the adhesive of De Keyzer, as modified, is essentially the same as the claimed adhesive.

A prima facie case of obviousness (for a composition) does not require the solution of the same problem or recognition of the same advantages as the applicants invention. In re Dillon 16 USPQ2nd 1897 (CAFC, en banc, 1990), which overrules In re Dillon 13 USPQ 2nd 1337 and In re Wright 6 USPQ 2nd 1959.

The fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

The prior art need not express the same reason or motivation for making the composition as Appellants to establish unpatentability. In re Kemps, 97 F.3d 1427, 1430, 40 USPQ2d 1309, 1311 (Fed. Cir. 1996).

Conclusion


13. The additional prior art, listed on the attached FORM PTO 892, is cited as of interest in teaching adhesive compositions and are considered merely cumulative to the prior art *supra*.


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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (571)272-1110. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR 
09/25/04